OPINION OF THE U. S. COURT OF APPEALS FOR THE THIRD CIRCUIT

Argued June 15, 1970

Before BIGGS, MCLAUGHLIN and STALEY, *Circuit Judges*

(Filed September 29, 1970)

BIGGS, *Circuit Judge*.

The appeals at bar, four in number, concern themselves with the validity and infringement of Claim 2 of Jesnig's United States Patent No. 2,620,938 for the design of a container finish and a container cap. The patent was held invalid as obvious and also was held to be not infringed by the district court. 301 F.Supp. 768 (E.D. Pa., 1969). It is unnecessary to set out Claim 2 in this opinion for it is fully and correctly described *id. supra* 771-772. The substantial issue presented has never been ruled on directly by this court though possibly related dicta is to be found in the able opinion of Judge Weber of the United States District Court for the Western District of Pennsylvania in *Allen-Bradley Company v. Air Reduction Company*, 273 F.Supp. 930, 941 (1967), aff'd *per curiam* by this court, 391 F.2d 282 (1968). The appellant rests its case on an interpretation of Section 103, 35 U.S.C.,[1] declared by the United States

1. Section 102, 35 U.S.C., provides in part: "*Conditions for patentability; novelty and loss of right to patent.*

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or . . ."

Section 103, 35 U.S.C., provides: "*Conditions for patentability; non-obvious subject matter.*

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this

Court of Customs and Patent Appeals in *Application of Palmquist*, 319 F 2d 547, at 551 (1963), which held that the time at which the determination of "invention" is to be made is "the time the invention was made" and that the principles established prior to the 1952 recodification of the patent laws apply to the determination of obviousness under Section 103, 35 USC. On the other hand, in *Application of Foster*, 343 F 2d 980 (1965), *cert. denied*, 383 US 906 (1966), decided approximately two years later, that Court held that where the time bar of Section 102(b) is involved the actual date of the invention becomes irrelevant and the applicant cannot dispose of a reference having a date more than one year prior to his filing date. By this decision the Court of Customs and Patent Appeals expressly overruled its holding in *Palmquist*.[2] 343 F 2d at 989. Such were the contrasting conclusions of the Court of Customs and Patent Appeals. In his opinion, however, the trial Judge in the instant case did not refer to either of the cited cases but seems to have based his conclusions strictly upon the provisions of Section 103, 35 USC, but used references which occurred after the date of Jessing's invention. The appellant contends that the conclusions of the trial court were erroneous and seems to have bottomed its appeal on the issue of the validity of the patent on the holding in *Palmquist*.

The facts can be stated briefly as follows. Jessing's invention date is February 4, 1947.[3] The date of filing of the '938 application was September 2, 1949, which would put the date of the statutory time bar at September 2, 1948.

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title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

2. The governing principle of *Application of Foster* is succinctly stated in the dissenting opinion of Judge Smith (who wrote the opinion in Palmquist), 343 F 2d at 989.

3. See Finding of Fact 9. Cf. Finding No. 11, 301 F. Supp. at 770.

The appellant points out that the district court considered at least nine references relevant to Jesnig's "invention" as part of the prior art. These references have dates between February 4, 1947 and September 2, 1948, inclusive, and are as follows: Sale of Lumelite Caps, Seagrams, after February 10, 1947;[4] July 1947, sale of Kitchen Cap with Flexeal Finish, July 1947 filing date of abandoned Barnby application;[5] sale of Lumelite Caps, Seagrams, October 1947, February 1948, publication "Precocious Plastics";[6] May 1948, filing date of previous Jesnig Patent No. 2,576,416, after May 1, 1948, sale of Lumelite Caps (Kroger),[6] and June 1948, filing date of Randlett Patent No. 2,576,416. No one of the listed references completely disclose the Jesnig invention, but the trial Judge concluded that in the aggregate they rendered the Jesnig invention obvious. We agree.

If the standard of *Foster* is correct, the district court did not err in considering the foregoing items but if the test of *Palmquist* is applied, as contended for by the appellant the District Judge should have excluded all the items referred to in the preceding paragraph from his consideration.[7] The issue presented for our determination, therefore, on this phase of the instant case is the point of time from which obviousness must be observed. The appellees contend that it is clear that the deci-

4. It would appear from the record, however, that the Lumelite Caps, Seagrams, were sold as early as 1945. The point, however, is unimportant in view of our decision.

5. The Barnby application was in no wise relied on by the district court as part of the prior art but was expressly rejected in the Court's consideration, and rightly so. 301 F. Supp. at 779.

6. Four publications including "Precocious Plastics" were considered by the District Judge.

7. The parties are agreed, as indeed they must be, both citing the Deere trilogy (*Graham v. John Deere Co.*, 383 U.S. 1, 12-17 (1966)), that non-obviousness is a necessary condition for patentability and that this was made a statutory requirement by the 1952 Patent Act which codified a principle originally enunciated by the Supreme Court in 1851 in *Hotchkiss v. Greenwood*, 11 How. 248.

sion in *Foster* is correct, relying principally on the theory that the phrase "at the time the invention was made" was included in the 1952 statute to preclude the use of hindsight in deciding whether or not the invention is obvious.

Section 103, 35 U.S.C., speaks of a patent being obvious at the time of the invention date. Section 102(b) teaches that patents are invalid if published or described more than one year prior to the date of the patent application, *i.e.*, there is a time bar of one year. *Foster* puts the obviousness test of Section 103 by implication into Section 102(b).

The district court in the case at bar correctly held, in substance, that the differences between the prior art and the claimed invention is to be determined by "the level of ordinary skill in the pertinent art", citing *Graham v. John Deere Co.*, 383 U.S. 1 (1966). It is clear, however, that *Foster* permits a multiplicity of prior art references which, added together, demonstrate obviousness. As stated previously there are prior art references published more than one year prior to the date of Jesnig's invention. If the doctrine of *Foster* be applied the patent at bar would be invalid for want of patentability if, as we have held, the references to the prior art, hereinbefore specifically referred to, constitute obviousness. As we have indicated the contrary would be the case if the *Palmquist* doctrine of a single reference be employed. At the risk of needless repetition and for the sake of clarity, we reiterate that what *Foster* teaches is that Section 102(b) containing the critical bar date of one year prior to the patent application as the time for determining patentability implicitly contains the obviousness test of Section 103. We believe that *Foster* was correctly decided and we deem it unnecessary to elucidate the facts of *Foster* and the reasoning of Judge Almond. We find his opinion to be clear and convincing, particularly when read in the light of the concurring and dissenting opinions and we think that we can add no cogency to it. Applying the *Foster* doctrine, we find that the Jesnig's invention was not patentable. We conclude that

the District Court in bottoming its decision on Section 103 did not apply the correct standard of law but that it did reach the right result. We therefore hold Claim 2 of the patent in suit invalid on the ground that patentability was barred to Jesnig under Section 102(b) for the reasons stated.[8]

We think it unnecessary to write on the issue of infringement. We find the reasoning and the conclusion of the District Court to be correct.[9]

The judgment of the district court will be affirmed.

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8. There are, of course, decisions seemingly contrary to *Application of Foster* in other Circuits. See *Walker v. General Motors Corp.*, 362 F.2d 56, 58 (1966); *Ceramic Fibers Supply Co. v. Tile Council of America, Inc.*, 378 F.2d 284 (9 Cir. 1967); *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F.2d 381, 398 (10 Cir. 1965), and *Spindelfiber Corp. v. United States*, 360 F.2d 954, 960 (Ct. Cl. 1966).

9. In view of our decision we find it unnecessary to deal with any issue that could be raised by Jesnig 2,587,327, cited in the text of the patent in suit. See 301 F. Supp. at 770 and 778. The contentions of the appellees as to the disclosures of this patent are not clear.

A True Copy:

Teste:

Clerk of the United States Court of Appeals for the Third Circuit

PATENT OFFICE RULE 131

Affidavit or declaration of prior invention to overcome cited patent or publication.

(a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath or declaration as to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

(b) The showing of facts shall be such, in character and weight as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.